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REMARKS

This is a full and timely response to the non-final Official Action mailed September 7, 2007 (the "Action"). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the forgoing amendment, various claims have been amended. However, none of the claims amendments are substantive and are not intended to, and do not, change or narrow the scope of any claim.

No claims have been cancelled or added. Thus, claims 1-45 are currently pending for further action.

Objection to Claims:

The recent Office Action objected to claims 1, 4 and 19 due to alleged informalities. Accordingly, Applicant responds as follows.

Claim 1 has been amended as requested in the Office Action to address an obvious typographical error. This amendment makes no change to the scope of claim 1. Following this amendment, the objection to claim 1 may be reconsidered and withdrawn.

Claim 4 has been reviewed, but has not been amended. With regard to claim 4, the Office Action requested that the phrase "a print job" be amended to recite "said print job." However, in the instance referred to, claim 4 is not necessarily referring to a specific previously-recited print job, but to any incoming print job. Consequently, claim 4 is thought to be correct as originally presented. For this reason, the objection to claim 4 should be reconsidered and withdrawn.

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Claim 19 has been review, but has not been amended. With regard to claim 19, the Office Action requested the phrase "with printing device" be amended to "with said printing device." However, in this instance, the phrase "printing device" is an adjective that modifies the phrase "configuration settings." Consequently, the amendment suggested by the Office Action, if adopted would actually appear to create a lack of antecedent basis for the indicated recitation of claim 19. Therefore, claim 19 is thought to be correct as originally presented. For this reason, the objection to claim 19 should be reconsidered and withdrawn.

35 U.S.C. § 101:

The recent Office Action rejected claims 44 and 45 under 35 U.S.C. § 101 because the claims used slightly different terminology than the Examiner prefers. Accordingly, claim 44 has been amended herein to adopt the specific language requested in the Office Action. Applicant maintains, however, that this is purely formalistic and has absolutely no bearing on the scope of the claims. Following this amendment, the rejection of claims 44 and 45 should be reconsidered and withdrawn.

35 U.S.C. § 112, second paragraph:

The recent Office Action rejected claims 3, 26 and 31 under 35 U.S.C. § 112, second paragraph. These claims have been carefully reviewed in light of the Examiner's comments, and the Applicant responds as follows.

With regard to claim 3, the Office Action argues that the recitation "retrieving settings" is confusing in that "[i]t is unclear if these retrieved settings are different from *the obtained settings* recited in claim 2." (Action, p. 3) (emphasis in original). Claim 31 was rejected for similar reasons. (Action, p. 3). Applicant respectfully disagrees.

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Claim 2 recites “querying a database to obtain settings for said printing device associated with said identifier.” Claim 3 recites “wherein said querying a database comprises: ... retrieving settings for said printing device.” (Emphasis added). Thus, the explicit language of claim 3 clarifies the relationship between “querying a database to obtain settings” in claim 2 and the manner in which that “querying to obtain” is performed as recited in claim 3. The same is true of claims 30 and 31.

For at least these reasons, claims 3 and 31, as originally presented, are in full compliance with § 112. Thus, this rejection of claims 3 and 31 should be reconsidered and withdrawn.

Claim 26 was rejected because the recitations “the source location of said data” allegedly lacked antecedent basis. (Action, p. 3). Accordingly, claim 26 has been amended herein to clarify the noted recitation. Following entry of this amendment, the rejection of claim 26 may be reconsidered and withdrawn.

Prior Art:

Claims 1-7, 9, 16-19, 21, 24-26, 28-35, 37 and 42-44 were rejected as anticipated by 35 U.S.C. § 102(e) by U.S. Patent No. 6,658,456 to Shimoosawa (“Shimoosawa”). For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites: “A method of configuring a printing device, said method comprising dynamically modifying printing device settings based on an identifier in an incoming print job identifying a client submitting said print job.” Applicant notes that claim 1 recites modifying printing device settings based on the identity of “a client *submitting* said print job.” (Emphasis added).

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In contrast, Shimoosawa fails to teach or suggest any of this subject matter. Moreover, the Office Action utterly fails to establish how or where Shimoosawa teaches or suggests the claimed subject matter.

Shimoosawa teaches system for handling email. Particularly, Shimoosawa teaches “[a]n electronic mail transferring apparatus for transferring electronic mail to a designated destination.” (Shimoosawa, claim 1). According to Shimoosawa, “a memory [is] configured to store a plurality of destination addresses and transfer attributes, a transfer attribute associated with each *destination address*.” (*Id.*) (emphasis added). Thus, Shimoosawa teaches “transfer attributes” for an email that are based on the email’s “destination address.” There is nothing here relevant to the claimed modifying of printing device settings based on the identity of “a client *submitting* said print job.” (emphasis added).

Shimoosawa does teach that “the content of the e-mail including the appended file portion can be printed.” (*Id.* at col. 11, lines 37-38). However, Shimoosawa does not teach or suggest anything about printing device settings being modified “based on an identifier in an incoming print job identifying a client submitting said print job” as recited in claim 1.

In rejecting claim 1, the Office Action cites Shimoosawa at col. 5, lines 13-52 and col. 11, lines 16-50. Neither of these portions of Shimoosawa, however, ever mention, let alone teach or suggest, modifying printing device settings. Rather, as noted above, col. 11 merely notes that “the content of the e-mail including the appended file portion can be printed.” (*Id.* at col. 11, lines 37-38). Clearly, the mere teaching that the content of an email can be printed utterly fails to anticipate the subject matter of claim 1 including “modifying printing device settings based on an identifier in an incoming print job identifying a client submitting said print job.”

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"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. In the present instance, Shimoosawa clearly fails to teach or suggest "modifying printing device settings based on an identifier in an incoming print job identifying a client submitting said print job." Moreover, the Office Action fails to demonstrate or indicate how or where Shimoosawa could be understood to teach such subject matter. For at least these reasons, the rejection based on Shimoosawa of claim 1 and its dependent claims should be reconsidered and withdrawn.

Independent claim 18 similarly recites:

A printing device comprising:  
an input for receiving a print job; and  
a print engine configured to produce a hardcopy from said print job;  
wherein said printing device extracts an identifier from said print job and  
adjusts printing device configuration settings based on said identifier.

In rejecting claim 18, the Office Action merely refers to the same portions of Shimoosawa cited in the rejection of claim 1. However, as amply demonstrated above, Shimoosawa does not teach or suggest the claimed printing device that "extracts an identifier from said print job and adjusts printing device configuration settings based on said identifier."

Rather, Shimoosawa teaches "transfer attributes" for an email that are based on the email's "destination address." (Shimoosawa, claim 1). According to Shimoosawa, the "transfer attributes include[] discriminators that identify a type of data of the electronic mail, the transfer attributes further including an indicator that an appended file portion is to be deleted." (*Id.*).

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Thus, Shimoosawa teaches a system that selects transfer attributes for an email message that effect how the email message is transferred based on its destination address. This has nothing to do with, and certainly does not anticipate, the claimed printing device that “adjusts printing device configuration settings based on [an included] identifier.” (Claim 18). Shimoosawa never mentions adjusting printing device configuration settings based on an identifier included in a print job.

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Shimoosawa of claim 18 and its dependent claims should be reconsidered and withdrawn.

Independent claim 29 similarly recites:

A system for configuring a printing device, said system comprising:  
means for extracting an identifier from an incoming print job identifying a client submitting said print job; and  
means for dynamically modifying printing device settings based said identifier.

The Office Action does not specifically address the language of claim 29, but merely rejects it base on “arguments analogous to those presented for” claim 1. (Action, p. 7). Accordingly, as demonstrated above with respect to claim 1, Shimoosawa clearly fails to teach or suggest “means for extracting an identifier from an incoming print job *identifying a client submitting said print job*; and means for dynamically *modifying printing device settings based said identifier*.” (Emphasis added).

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single

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prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Shimoosawa of claim 29 and its dependent claims should be reconsidered and withdrawn.

Independent claim 44 recites:

A computer readable medium having computer executable instructions thereon which, when executed, cause a printing device to:  
scan a print job for an identifier;  
obtain configuration settings associated with said identifier; and  
configure said printing device according to said configuration settings.

The Office Action does not specifically address the language of claim 44, but merely rejects it base on “arguments analogous to those presented for claims 1 and 2.” (Action, p. 7).

Accordingly, as demonstrated above with respect to claim 1, Shimoosawa clearly fails to teach or suggest instructions causing a printing device to “scan a print job for an identifier; obtain configuration settings associated with said identifier; and configure said printing device according to said configuration settings.” As demonstrated above, Shimoosawa has not been shown to teach or suggest any of this subject matter.

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Shimoosawa of claim 44 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

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Claim 2 recites “scanning data packets of said print job for said identifier; querying a database to obtain settings for said printing device associated with said identifier; and configuring said printing device according to said settings associated with said identifier.” In this regard, the Office Action cites Shimoosawa at Fig. 4 as teaching “querying a database to obtain settings for said printing device.” (Action, p. 4). However, Fig. 4 of Shimoosawa merely shows “transfer attributes,” as described and defined above. Fig. 4 does not include settings for a printing device as recited in claim 2. For at least this additional reason, the rejection of claim 2 and its dependent claims should be reconsidered and withdrawn.

Claim 16 recites “determining a group to which said printing device belongs based on said identifier.” In this regard, the Office Action states that Shimoosawa teaches this subject matter in that “a group belongs to \*@rdmg.mgcs.or.jp in col. 5, lines 20-28.” (Action, p. 5). However, this is merely the address from which an email is received. In the cited portion of Shimoosawa, the reference states that “the e-mail is received from “\*@rdmg.gcs.mei.co.jp”, which is the content of the sender ID column.” (Shimoosawa, col. 5, lines 20-28). Clearly, this has nothing to do with “determining a group to which [a] printing device belongs based on said identifier.” A printing device is not even mentioned. Thus, it unclear how the Office Action can conclude that this portion of Shimoosawa is relevant to claim 16. For at least this additional reason, the rejection of claim 16 and its dependent claims should be reconsidered and withdrawn.

Claims 8, 13, 14, 20, 36 and 45 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Shimoosawa and U.S. Patent No. 5,434,775 to Sims et al. (“Sims”). This rejection is respectfully traversed for the same reasons given above in favor of the patentability of claim 1.



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Additionally, claim 20 recites “further comprising a database associating identifiers with printing device locations and printing device locations with printing device configuration settings.” Claim 36 recites similar subject matter. In this instance, the Office Action fails to indicate how or where the cited prior art teaches a database that associates “printing device locations with printing device configuration settings” as claimed.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Shimoosawa and Sims, did not include the claimed database that associates “printing device locations with printing device configuration settings.” This subject matter appears to be entirely beyond the scope and content of the cited prior art and provides functionality and advantages that were unknown and unavailable in the prior art as explained in Applicant’s specification. For at least these additional reasons, Shimoosawa and Sims will not support a rejection of claims 20 and 36 under 35 U.S.C. § 103 and *Graham*.

Claims 10, 11, 22, 23, 38 and 39 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Shimoosawa and U.S. Patent App. Pub. No. 2004/0098471 to Shima (“Shima”). This rejection is respectfully traversed for the same reasons given above in favor of the patentability of claims 1, 18 and 29.

Claims 12 and 40 were rejected under 35 U.S.C. § 103(a) over the teachings of Shimoosawa taken alone. This rejection is respectfully traversed for the same reasons given above in favor of the patentability of claims 1 and 29.

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Claims 15 and 41 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Shimoosawa and U.S. Patent App. Pub. No. 2004/0201860 to Nakaoka et al. ("Nakaoka").

This rejection is respectfully traversed for the same reasons given above in favor of the patentability of claims 1 and 29.

Lastly, claim 27 was rejected under 35 U.S.C. § 103(a) over the combined teachings of Shimoosawa and U.S. Patent App. Pub. No. 2001/0025307 to Venkatranman et al. ("Venkatranman"). This rejection is respectfully traversed for the same reasons given above in favor of the patentability of claim 18.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further,

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for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: December 7, 2007

  
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